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EXAMINER

GODENSCHWAGER, PETER T

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Response to Amendment***

The Declaration under 37 CFR 1.132 filed March 18, 2010 is insufficient to overcome the rejection of claims 1 and 2 based upon Ettlinger et al. (EP 0672731) under 35 U.S.C. 102(b) and the rejection of claim 4 based upon Ettlinger et al. in view of Koehlert et al. (US Pat. No. 5,928,723) under 35 U.S.C. 103(a) as set forth in the last Office action because: The Declaration does not provide any factual evidence to demonstrate that one of ordinary skill in the art would not reasonably interpret the phrase "structurally modified" to include the *molecular* structure modifications as taught by Ettlinger et al. (Pg. 1, Lns. 15-25 and Pg. 1, Lns. 30-32 of English machine translation), or provided any factual evidence demonstrating how the term "structurally modified" is reasonably interpreted in the art. Furthermore, the instant specification has not defined the term "structurally modified" to *exclude* such *molecular* structure modifications. It is further noted that while on Pg. 3, first full paragraph of the declaration, it is stated that Ettlinger does not teach anything about "'structural modifications' by mechanical action (e.g. by milling)", it is noted that structural modifications specifically by mechanical action (e.g. by milling), have not been claimed. As Ettlinger et al. teaches modifying the molecular structure of the silica, such a modification is reasonably interpreted as structurally modifying the silica.

The declaration further makes note of two photographs claiming to show both "structure modified" pyrogenic oxide and pyrogenic oxide that is "not structure modified". As an initial matter, it is not clear how these photographs are relevant to the issue of how to interpret the term "structurally modified" as they make no mention as to what, if any, physical or chemical manipulations have been done to the pyrogenic oxide that is "structure modified". Secondly, there is no evidence that the "structure modified" silica of the photograph is within the scope of

the claimed material, and if it is, there is no evidence provided or explanation as to how it the material differs from the prior art material (i.e. Ettlinger et al.).

### ***Response to Arguments***

Applicant's arguments filed March 18, 2010 have been fully considered but they are not persuasive.

Applicant's arguments regarding the Declaration under 37 CFR 1.132 filed March 18, 2010 have been sufficiently responded to above.

It is further noted with regard to the issue of the interpretation of the term "structure modified" that the specific limitation of "structure-modified, pyrogenically prepared metalloid" is a product-by-process limitation. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [See MPEP 2113].

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER F. GODENSCHWAGER whose telephone number is (571)270-3302. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

/P. F. G./  
Examiner, Art Unit 1796